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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,141	12/29/2000	Joshua L. Coates	SCAL.P0003	1810

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EXAMINER

LE, HIEU C

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 07/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/753,141

Applicant(s)

COATES ET AL

Examiner

Hieu c. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 11-18 and 21-23 is/are rejected.
- 7) ☒ Claim(s) 9, 19-20 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 4-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 recites the limitation " step of embedding " in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 5 recites the limitation " step of embedding " in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claims 6-8, refer to claim 4 rejection.

Claim Rejections - 35 U.S.C. § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351 (a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3,12-14,21-23 are rejected under 35 U.S.C. 102(e) as anticipated by Granik et al. (US 2002/0010757).

As to claim 1, Granik discloses a method for downloading a file from a remote storage center to an end-user computer for content provided from a content server (Fig.

1), said method comprising the steps of:

receiving a request from an end-user computer for content at a content server
(col. 4, [00370, lines 1-5):

transmitting from said content server to said end-user computer, in response to said end-user request, said content comprising at least one storage resource locator ("SRL"), wherein said SRL, comprises a unique file identifier to identify a file associated with said content [the user downloads a replacement ad/image (content) from server 24 (col. 4; [0037], lines 6-10) i.e. content is transmitted to the user. The ad/image (content) includes accompany data such as URL (unique identifier to identify a file associated with the content) (col. 5, [0040], lines 6-9), the URL is storage resource locator because it is a link that identifies the address the file is stored at]

transmitting a request for said file from said end-user computer to a remote storage center, including transmitting said SRL for said file [col. 5, [0043], lines 1-16];
and

transmitting, from said storage center to said end-user computer, said file identified by said SRL [new content replacement files are sent to the user (col. 5, [0043] lines 16-19].

As to claim 2, Granik further discloses further comprising the steps of:

determining, at said storage center, using said authentication certificate, whether said request is valid [col. 4, [0029]; and

transmitting, from said storage center to said end-user computer, said file only if said request is valid [col. 5, [0040]; lines 1-6] .

As to claim 3, Granik further discloses further comprising the steps of:

transmitting to said end-user computer an SRL further comprising a time-out parameter [activation and deactivation times of images (time out parameter (col.5, [0040], lines 10-16)]; and

determining whether said request is valid through said time-out parameter [users accounts are deleted after a predefined amount of time of inactivity (time out parameter) (col. 5, [0040], lines 17-19)].

As to claim 12, refer to claim 1 rejection.

As to claim 13, refer to claim 2 rejection.

As to claim 14, refer to claim 3 rejection.

As to claim 21, refer to claim 1 rejection.

As to claim 22, refer to claim 2 rejection.

As to claim 23, refer to claim 3 rejection.

Claim Rejections - 35 U.S.C. § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4-7, 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Granik et al. (US 2002/0010757), as applied to claim 1 and further in view of Schleimer et al (6,108,655).

As to claim 4, Granik discloses a replacing the original content with new content after receiving the users request and based on user information, and including URL in

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the content for enabling user access to a destination web site providing the new content (col. 1 [0041]).

Granik does not disclose the URL (SRL) is embedded the content. However, embedding URL in web pages is well known and conventional in the art as disclosed by Schleimer.

Schleimer discloses a sever-client system where HTML components (URL) are embedded in web pages (Fig. 6A & 6B).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Schleimer's teachings to modify Granik's method by embedding the URL (SRL) in the web page (content) in order to be able to identify the location where the content is stored and be able to retrieve it.

As to claim 5, Granik further discloses transmitting content as web pages and including a URL (SRL) in the content for enabling user access to destination web site providing the new content (col. 1, [0040]).

Granik does not disclose that the web pages are hyper-text mark-up language ("HTML") content; and dose not disclose the URL (SRL) is embedded in the web page (content).

Howerver using hyper-text mark-up language ("HTML") in web pages and embedding URL in the web page (content) are well known and conventional in the art.

Schleimer discloses a sever-client system where web pages in HTML are analyzed and HTML components (URL) are embedded in web pages (Fig. 6A & 6B).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Schleimer's teachings to modify Granik's method by using HTML in web pages (content) and embedding URL (SRL) in the HTML pages in order to be able to identify the location where the content is stored and be able to retrieve it.

As to claim 6, Granik further discloses wherein the step of embedding said SRL into said content comprises the steps of:

storing at least one SRL for a file in an SRL file [Fig. 6B; item 100 is a URL (SRL) and a file <IMGSRG= "/top gif > is store in the URL] and

extracting said SRL from said SRL file [Fig. 6B; item 104 is an extracted URL (SRL) from URL file].

As to claim 7, Granik further discloses wherein the step of embedding, said SRL into said content comprises the steps of:

coupling a local device comprising (a cache to said content server (col. 7, lines 8-10):

storing at least one SRL for at least one file in said cache of said local device (col. 7, lines 10-13): and

extracting said SRL, from said cache of said local device [col. 7, lines 37-42).

As to claim 15, refer to claim 4 rejection.

As to claim 16, refer to claim 5 rejection.

As to claim 17, refer to claim 6 rejection.

As to claim 18, refer to claim 7 rejection.

7. Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Granik et al. (US 2002/0010757), as applied to claim 1 and further in view of Shuping et al (2002/0054114).

As to claim 10, Granik further discloses using a web browser to request web page contents from a remote storage system [col. 1, [0014].

Granik does not discloses the use of hyper-textt transfer protocol (HTTP) in the request and using HTTP to transmit files.

Shuping discloses a system for retrieving web pages from a server using a web browser that sends request using URL associated with the page. The request is passed through a network using appropiate network protocol, for example the Internet, a Hyper-text transfer protocol HTTP is used (col. 2 [0034]) the requested web page is send back to user computer using HTTP (col. 3, [0035]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Shuping teachings to modify Granik's method by using HTTP and receives the web pages from the server using HTTP in order to facilitate the transmission of the request and the retrieved web pages through a network such as the Internet.

As to claim 11, Granik further discloses wherein the step of transmitting, from said storage center to said end-user computer, said file comprises the step of transferring a large media object [files transferred are advertising content (large media object) (col. 1, [0009].

Claim 8 would be allowable if it overcomes the 112, 2nd paragraph rejection, and rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Allowable Subject Matter

7. Claims 9,19,20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hieu Le whose telephone number is (703) 306-3101. The examiner can normally be reached on Monday to Friday from 7:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Harvey, can be reached on (703) 305-9705. The fax phone number for this Group is (703) 308-9051.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Hieu Le


JACK B. HARVEY
SUPERVISORY PATENT EXAMINER